



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,745	10/27/2003	Kohich Kanaya	244226US2	8851
22850	7590	07/30/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
TRAN, NGHI V				
ART UNIT		PAPER NUMBER		
2151				
NOTIFICATION DATE		DELIVERY MODE		
07/30/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/692,745

Applicant(s)

KANAYA, KOHICH

Examiner

NGHI V. TRAN

Art Unit

2151

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-12 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-12 and 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the amendment filed on May 13, 2008. Claims 7, 10, and 16 have been amended. Claims 1-6 and 13-15 have been canceled. Claim 19 has been previously added. Therefore, claims 7-12 and 16-19 are presented for further examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 13, 2008 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2151

4. Claims 7-12 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goddard et al., United States Patent Number 6,622,266 (hereinafter Goddard), in view of McCarthy, Jr., United States Patent Number 7,031,009 (hereinafter McCarthy).

5. With respect to claims 7, 10, and 16, Goddard teaches an image processing apparatus [= a plurality of printers and/or other output devices **106, 108, 110, 112, and/or 114**] connected to a network [= enterprise network 104] and operative to report a job progressing condition [= alert condition prompting the alert, see abstract such as paper jam, toner low, and output full **216**] to a user terminal apparatus [= user unit **116, 120, and/or 124**] requesting a job by the network, said image processing comprising:

- a first controller [= printer management utility **204**] configured to determine if at least one job is completed or interrupted in the image processing apparatus [= configuration of alert notification recipients for all possible alert conditions for any enterprise printer to be configured utilizing printer, col.3, ll.31 through col.4, ll.63];
- an electronic mail [= email server **218**] transmitting device configured to transmit an electronic mail [= email notification alert] including a printer alert notification [= notification recipient alert type such as load paper offline, tray missing, toner low, paper jam, etc. **216** of fig.2] representing the information source, without transmitting the generated thumbnail image data [= all alert

notifications email including a display of alert type **216**], to a mail address assigned to the user terminal apparatus when the job is completed or interrupted;

- a second controller [= email server] configured to allow the user terminal apparatus having the mail address to access the information source by a browser displayed on the terminal apparatus [= email server **218** forward the alert notifications to the appropriate user unit **116**, **120**, or **124** where the corresponding individual is logged in, col.4, ll.39-63].

However, Goddard does not explicitly show transmitting an electronic mail including a URL representing the information source with a thumbnail image data generating device configured to generate thumbnail image data of first page of the job and allowing the terminal apparatus to obtain the thumbnail image data, wherein said thumbnail image data is stored in an information source provided in the image processing apparatus.

In a related art, McCarthy discloses transmitting an electronic mail including a URL representing the information source with a thumbnail image data generating device configured to generate thumbnail image data of first page of the job [= the email server **28** notifies the user's email's client **30** of the available email, col.2, ll.57-59, including the document capture system to solicit document metadata from a user, col.1, ll.32-33, and col.2, ll.63-64, wherein the document metadata includes a URL to the first page of the scanned document, col.2, ll.38-39] and allowing the terminal apparatus to obtain the thumbnail image data [= the user's mail client **30** wishes to view the available email,

col.2, ll.17-67], wherein said thumbnail image data is stored in an information source provided in the image processing apparatus [see abstract and col.1, ll.31-59].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Goddard in view of McCarthy by configuring to generate a thumbnail image data of a first page of a job because this feature is supported by the repository system for the captured document [McCarthy, col.1, ll.37-38]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated in order to remind the user about the particular document [McCarthy, col.4, ll.40].

6. With respect to claims 8, 11, and 17, Goddard further teaches wherein the mail address is associated with a user code representing a user [fig.2].

However, Goddard does not explicitly show wherein the image processing apparatus is operable when the user code is input and authenticated.

In a related art, McCarthy suggests wherein the image processing apparatus is operable when the user code is input and authenticated [i.e. a user 10 logs in and selects, enters or is associated with basic capture parameter, col.2, ll.16 through col.4, ll.47].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Goddard in view of McCarthy by operating when the user code is input and authenticated because this feature is supported by the repository system for the captured document [McCarthy, col.1, ll.37-38]. It is for this

Art Unit: 2151

reason that one of ordinary skill in the art at the time of the invention would have been motivated in order to remind the user about the particular document [McCarthy, col.4, ll.40].

7. With respect to claims 9, 12, 18, and 19, Goddard does not explicitly show wherein the user code is authenticated by accessing a user code table listing users permitted to request the job.

In a related art, McCarthy suggests wherein the user code is authenticated by accessing a user code table listing users permitted to request the job [col.2, ll.16 through col.4, ll.47].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Goddard in view of McCarthy by accessing a user code table listing users permitted to request the job because this feature is supported by the repository system for the captured document [McCarthy, col.1, ll.37-38]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated in order to remind the user about the particular document [McCarthy, col.4, ll.40].

Response to Arguments

8. Applicant's arguments filed May 13, 2008 have been fully considered but they are not persuasive because of the following: Goddard teaches an image processing apparatus [= a plurality of printers and/or other output devices **106, 108, 110, 112,**

Art Unit: 2151

and/or **114**] connected to a network [= enterprise network 104] and operative to report a job progressing condition [= alert condition prompting the alert, see abstract such as paper jam, toner low, and output full **216**] to a user terminal apparatus [= user unit **116**, **120**, and/or **124**] requesting a job by the network, said image processing comprising: a first controller [= printer management utility **204**] configured to determine if at least one job is completed or interrupted in the image processing apparatus [= configuration of alert notification recipients for all possible alert conditions for any enterprise printer to be configured utilizing printer, col.3, ll.31 through col.4, ll.63]; an electronic mail [= email server **218**] transmitting device configured to transmit an electronic mail [= email notification alert] including a printer alert notification [= notification recipient alert type such as load paper offline, tray missing, toner low, paper jam, etc. **216** of fig.2] representing the information source, without transmitting the generated thumbnail image data [= all alert notifications email including a display of alert type **216**], to a mail address assigned to the user terminal apparatus when the job is completed or interrupted; a second controller [= email server] configured to allow the user terminal apparatus having the mail address to access the information source by a browser displayed on the terminal apparatus [= email server **218** forward the alert notifications to the appropriate user unit **116**, **120**, or **124** where the corresponding individual is logged in, col.4, ll.39-63]. However, Goddard does not explicitly show transmitting an electronic mail including a URL representing the information source with a thumbnail image data generating device configured to generate thumbnail image data of first page of the job and allowing the terminal apparatus to obtain the thumbnail image data, wherein said

thumbnail image data is stored in an information source provided in the image processing apparatus. In a related art, McCarthy discloses transmitting an electronic mail including a URL representing the information source with a thumbnail image data generating device configured to generate thumbnail image data of first page of the job [= the email server **28** notifies the user's email's client **30** of the available email, col.2, ll.57-59, including the document capture system to solicit document metadata from a user, col.1, ll.32-33, and col.2, ll.63-64, wherein the document metadata includes a URL to the first page of the scanned document, col.2, ll.38-39] and allowing the terminal apparatus to obtain the thumbnail image data [= the user's mail client 30 wishes to view the available email, col.2, ll.17-67], wherein said thumbnail image data is stored in an information source provided in the image processing apparatus [see abstract and col.1, ll.31-59]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Goddard in view of McCarthy by configuring to generate a thumbnail image data of a first page of a job because this feature is supported by the repository system for the captured document [McCarthy, col.1, ll.37-38]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated in order to remind the user about the particular document [McCarthy, col.4, ll.40].

9. In response to applicant's arguments that it's not clear the McCarthy's URL is sent to a user, the examiner respectfully disagrees. McCarthy discloses the email server **28** notifies the user's email's client **30** of the available email [col.2, ll.17-65]

including the document capture system to solicit document metadata from a user [col.1, ll.32-33 and col.2, ll.63-64]. The document metadata of McCarthy includes a URL to the first page of the scanned document [col.2, ll.38-39]. Therefore, McCarthy discloses claimed feature as show in the above.

10. In response to applicant's arguments that McCarthy discloses a contrary structure an opeartion, the examiner respectfully disagrees. First, Applicant obviously attacks references individually without taking into consideration based on the teaching of combinations of references as show in the above. one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Goddard teaches an electronic mail [= email server **218**] transmitting device configured to transmit an electronic mail [= email notification alert] including a printer alert notification [= notification recipient alert type such as load paper offline, tray missing, toner low, paper jam, etc. **216** of fig.2] representing the information source, without transmitting the generated thumbnail image data [= all alert notifications email including a display of alert type **216**], to a mail address assigned to the user terminal apparatus when the job is completed or interrupted. However, Goddard does not explicitly show transmitting an electronic mail including a URL representing the information source with a thumbnail image data generating device configured to generate thumbnail image data of first page of the job and allowing the terminal apparatus to obtain the thumbnail image data,

wherein said thumbnail image data is stored in an information source provided in the image processing apparatus. In a related art, McCarthy discloses transmitting an electronic mail including a URL representing the information source with a thumbnail image data generating device configured to generate thumbnail image data of first page of the job [= the email server **28** notifies the user's email's client **30** of the available email, col.2, ll.57-59, including the document capture system to solicit document metadata from a user, col.1, ll.32-33, and col.2, ll.63-64, wherein the document metadata includes a URL to the first page of the scanned document, col.2, ll.38-39] and allowing the terminal apparatus to obtain the thumbnail image data [= the user's mail client **30** wishes to view the available email, col.2, ll.17-67], wherein said thumbnail image data is stored in an information source provided in the image processing apparatus [see abstract and col.1, ll.31-59]. Therefore, in the combination of Goddard-McCarthy discloses claimed feature as show in the above.

11. In response to applicant's argument that McCarthy cant not cure deficiencies in Goddard, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

12. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Goddard in view of McCarthy by configuring to generate a thumbnail image data of a first page of a job because this feature is supported by the repository system for the captured document [McCarthy, col.1, ll.37-38]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated in order to remind the user about the particular document [McCarthy, col.4, ll.40].

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi V. Tran whose telephone number is (571) 272-4067. The examiner can normally be reached on Monday-Thursday and every other Friday (6:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone

Art Unit: 2151

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nghi Tran
Patent Examiner
Art Unit 2151

June 18, 2008

/John Follansbee/
Supervisory Patent Examiner, Art Unit 2151